

## **REMARKS**

### **INTRODUCTION:**

In accordance with the foregoing, claims 4, 9, and 13 have been canceled without prejudice or disclaimer, and claims 1, 6, 7, 8, 10, 11, 12 and 14 have been amended. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1-3, 5-8, 10-12, and 14 are pending and under consideration. Reconsideration is respectfully requested.

### **REJECTION UNDER 35 U.S.C. §102:**

In the Office Action, at page 2-7, numbered paragraphs 3-14, claims 1, 2, 4-7, 9-11, 13, and 14 were rejected under 35 U.S.C. §102(e) as being anticipated by Gotou (USPN 7,085,629; hereafter, Gotou). This rejection is traversed and reconsideration is requested.

Claims 4, 9, and 13 have been canceled without prejudice or disclaimer.

The Examiner has indicated that Gotou discloses an electronic mail device comprising an additional information selection unit accepting a selection of the information in a case where the search unit has searched for plural pieces of information, in correspondence with claim 4 of the present invention.

However, claim 4 was intended to set forth a selection unit accepting a selection in a case where search results were plural pieces of information (see paragraph [0145] of the specification). To clarify this point, the terminology "searched for" has been amended to recite --searched out-- in independent claims 1, 6, 10 and 14, independent claims 1, 6, 10 and 14 have been amended for clarity, and claim 4 has been canceled without prejudice or disclaimer.

In addition, the present invention sets a file on the basis of a history of mail previously transmitted or received (see paragraphs [0145]-[0147], [0157], and [0163] of the specification). It is respectfully submitted that such a construction is not disclosed in any of the cited references, and hence, distinguishes the present invention over the cited references.

The construction of the present invention provides the advantage that a desired file may be selected in a case wherein the search unit has a plurality of files as a search result. Gotou does not teach or suggest such an advantage.

Hence, it is respectfully submitted that independent claims 1, 6, 10, and 14 of the present invention are not anticipated under 35 U.S.C. §102(e) by Gotou (USPN 7,085,629). Since claims 2, 5, 7, and 11 depend from amended independent claims 1, 6, and 10, respectively, claims 2, 5, 7 and 11 are not anticipated under 35 U.S.C. §102(e) by Gotou (USPN 7,085,629).

for at least the reasons amended independent claims 1, 6 and 10 are not under 35 U.S.C. §102(e) by Gotou (USPN 7,085,629).

**REJECTION UNDER 35 U.S.C. §103:**

In the Office Action, at pages 7-8, numbered paragraphs 16-19, claims 3, 8 and 12 were rejected under 35 U.S.C. §103(a) as being unpatentable over Gotou (USPN 7,085,629; hereafter, Gotou) as applied to claims 1, 2, 4-7, 9-11, 13, and 14 in the 35 U.S.C. §102(e) rejection above in view of Rast (US Publication 2001/0034769; hereafter, Rast). The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

Claims 4, 9, and 13 have been canceled without prejudice or disclaimer.

Gotou teaches a system for transmitting and receiving electronic mail of the present invention, wherein the system includes a text input means for entering a text of the electronic mail to be transmitted, an extracting means for extracting a character string to specify a place from the text inputted by the text input means, an adding means for adding information to the electronic mail, the information corresponding to the place specified by the extracted character string, a text display means for displaying the text in the electronic mail, and a map display means for displaying map information indicating the specified place corresponding to the information added to the electronic mail (see Abstract, Gotou). That is, Gotou teaches a system for extracting, from electronic mail, information indicating a specified place to send the electronic mail. The Examiner admits that Gotou does not explicitly teach extracting a data and time recorded in relative time since a data and time of transmission, an absolute date and time obtained from the present date and time, or the present date and time.

Rast teaches a system and method for sending temporally displaced electronic messages over a network from a sender to a recipient. The sending system is configured to allow the user to encode a temporal specifier into an electronic message to be sent over the network to a recipient at a destination address on the network. The electronic message is received over the network by a retention system which decodes the temporal specifier and stores the electronic message, sending to the destination in accord with the temporal specifier. In addition, the inventive teachings provide for the integration of additional content with the electronic messages and the use of cross-media communication of messages exemplified for escalating message priority. Rast does not teach or suggest utilizing a search unit to search for additional information corresponding to the keyword from an additional candidate storage unit stored with candidates for the additional information to the mail previously processed, utilizing an additional information selection unit to accept, in a case where the search unit has searched out

plural pieces of additional information, a selection, from a list of the plural pieces of additional information, of the information added, wherein the list has been sorted on a basis of a history of mails previously transmitted or received, and utilizing an adding unit to add the searched additional information to the electronic mail as the processing object, as is recited in the present claimed invention.

In contrast to the cited references, the present invention (see, for example, amended claim 1) utilizes a search unit to search for additional information corresponding to the keyword from an additional candidate storage unit stored with candidates for the additional information to the mail previously processed, utilizes an additional information selection unit to accept, in a case where the search unit has searched out plural pieces of additional information, a selection, from a list of the plural pieces of additional information, of the information added, wherein the list has been sorted on a basis of a history of mails previously transmitted or received, and an adding unit to add the searched additional information to the electronic mail as the processing object, which is not taught or suggested by Gotou or Rast, alone or in combination.

Thus, amended independent claims 1, 6, 10 and 14 of the present invention are submitted to be patentable under 35 U.S.C. §103(a) over Gotou (USPN 7,085,629) as applied to claims 1, 2, 4-7, 9-11, 13, and 14 in the 35 U.S.C. §102(e) rejection above in view of Rast (US Publication 2001/0034769), alone or in combination. Since claims 3, 8 and 12 depend from amended independent claims 1, 6, and 10, respectively, claims 3, 8 and 12 are patentable under 35 U.S.C. §103(a) over Gotou (USPN 7,085,629) as applied to claims 1, 2, 4-7, 9-11, 13, and 14 in the 35 U.S.C. §102(e) rejection above in view of Rast (US Publication 2001/0034769), alone or in combination for at least the reasons amended independent claims 1, 6 and 10 are patentable under 35 U.S.C. §103(a) over Gotou (USPN 7,085,629) as applied to claims 1, 2, 4-7, 9-11, 13, and 14 in the 35 U.S.C. §102(e) rejection above in view of Rast (US Publication 2001/0034769), alone or in combination.

## **CONCLUSION:**

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: March 15, 2007 By: Darleen J. Stockley  
Darleen J. Stockley  
Registration No. 34,257

1201 New York Avenue, N.W.  
Suite 700  
Washington, D.C. 20005  
Telephone: (202) 434-1500  
Facsimile: (202) 434-1501